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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/026,824 02/20/98 WINFREE

R TACOBEL.010A

EXAMINER

TM02/0503

KNOBEE MARTENS OLSON & BEAR  
620 NEWPORT CENTER DRIVE  
16TH FLOOR  
NEWPORT BEACH CA 92660-8016

BARTUSKA, F  
ART UNIT PAPER NUMBER

2167  
DATE MAILED:

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UNITED STATES DEPARTMENT OF COMMERCE  
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Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 17

Application Number: 09/026,824  
Filing Date: February 20, 1998  
Appellant(s): Winfree et al.

Robert J. Roby  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
MAY 3 2001  
Technology Center 2100

This is in response to appellant's brief on appeal filed March 20, 2001.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-3, 6, 7, 10, 11, 17, 18, 22-26, 44-47 and 55-63.

Claims 31, 50, 51 and 64 are allowed.

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4, 5, 8, 9, 13-16, 19-21, 27-30, 32-43, 48, 49 and 52-54 have been canceled.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

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**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: in the third issue the proper listing of claims is claims 55-59 and 61-63.

**(7) *Grouping of Claims***

The rejection of claims 1-3, 6, 7, 10, 11, 17 and 18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 44-47 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 55-59 and 61-63 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 22-26 and 60 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

A substantially correct copy of appealed claims 1-3, 6, 7, 10, 11, 17, 18, 22-26, 44-47 and 55-63 appears on pages 12-14 of the Appendix to the appellant's brief. The minor errors

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are as follows: claim 17, line 2 does not include the phrase: "that is arranged on the first section". This phrase was deleted by the amendment filed June 5, 2000, paper no. 13.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,163,536	TUHRO et al.	11-1992
5,573,082	CONLAN et al.	11-1996
5,628,245	BAZE	5-1997
4,974,500	BOYD et al.	12-1990

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 6, 7, 10, 11, 17, 18, 22-26, 44-47 and 55-63 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office action, Paper No. 14.

**(11) *Response to Argument***

The appellants argue that Tuhro et al and Conlan et al do not teach or suggest all the limitations of claims 1-3, 6, 7, 10, 11, 17 and 18. Specifically, the placement of a heated storage compartment along the first section and an open package storage compartment in the third section. The examiner is relying upon Tuhro et al which shows a heated storage compartment 22 along the first section and an open storage compartment 30 in the third section to meet these limitations in the claims. Tuhro et al do not disclose that the storage

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compartment 30 is for storing packages but this is just a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The appellants argue that the references do not show certain of the elements within six feet of each other. The examiner notes that if Tuhro et al is modified to be U-shaped as in the proposed rejections, all the elements of Tuhro et al would be pretty close to about six feet. Food service counters such as shown by Tuhro et al are generally about three feet high and each of the sections of Tuhro et al is about twice as long as they are high, so a U-shaped arrangement of the sections of Tuhro et al would place all the elements on the order of six feet apart. However, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device, see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

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The appellants argue that Tuhro et al as modified by Conlan et al do not show two work stations within arms reach of each other. It is the examiner's position that, as above, the dimensions of the device do not patentably distinguish the appellants' claims from the prior art. Further, the number of workers around the device is only a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The appellants argue that the beverage dispensing units of Conlan et al cannot be combined with the device of Tuhro et al because the beverage dispensing units of Conlan et al are along the outside of the food preparation area. It is the examiner's position that in view of the modular construction and the design flexibility teaching in col. 2, lines 19-32 of Tuhro et al any particular placement of the elements would be obvious. One of ordinary skill in the art would place the elements in the proper sequence to provide an efficient assembly line process of preparing the food to be served.

The examiner believes the motivation to combine the references to Tuhro et al and Conlan et al can be found in both Tuhro et al and Conlan et al. Tuhro et al suggest that different arrangements may be desirable in the disclosure in col. 2, lines 19-32 that the

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modular construction allows design flexibility and revision of equipment line-up. Conlan et al teaches that a U-shaped arrangement allows efficient operation by a single operator.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
F. J. BARTUSKA  
PRIMARY EXAMINER 5/1/01

fjb  
May 1, 2001

*DA* conf  
*LM* conf

KNOBEE MARTENS OLSON & BEAR  
620 NEWPORT CENTER DRIVE  
16TH FLOOR  
NEWPORT BEACH CA 92660-8016